



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : THOMAS R. GOECKE Examiner : NASSER AHMAD
Application No. : 10/674,108 Group Art : 1772
Filing Date : SEPTEMBER 29, 2003 Docket No. : 29006-2 (new)
Confirmation No. : 2438
Title : ADHESIVE TAPE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Examiner:

This cover sheet is in lieu of PTO/SB/33.

Applicant requests review of the Final Rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a concurrent Notice of Appeal. The review is requested for the reasons stated below (5 pages or fewer).

In re Goecke
Ser No.: 10/674,108, Filed: 9/29/03
Docket No.: 29006-2
Pre-Appeal Brief Request for Review

CLAIM SUMMARY

Claims 1-6 and 9 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,839,977 to Maurer (“Maurer”);

Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,461,715 to Guenther (“Guenther”); and

Claims 7, 10 and 11 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Maurer in view of Guenther.

REMARKS

Applicant respectfully traverses the final rejection of all the claims presently of record. To conform with the guidelines of the Pre-Appeal Brief Conference Pilot Project, Applicant limits the remarks here to those items believed to be clearly erroneous as set forth below.

As to Claims 1-6 and 9, the Office fails to make a *prima-facie* showing of obviousness. Specifically, the Office equates the claimed element “polymer layer” with the base member (54) of the Maurer reference. The Office concedes that Maurer teaches its base member as having a thickness of 0.08 to 0.14 inches (Final Office Action dated 3/23/06, paragraph 5, line 5). As this taught range clearly does not encompass the claimed range of 0.020 to 0.065 inches, the Office identified a different feature in the Maurer reference. Instead of continuing to reference the thin base member, the Office shifted its attention to an embodiment having a stepped configuration (Figure 14) showing an appliqu   (98) evenly divided into thirds. The thickest portion, that is the third identified by reference numeral 112, is disclosed as having a thickness of 0.048 inches.

The Office concludes that since this portion was within the claimed range, that Claim 1 was an obvious combination.

This is incorrect for several reasons. First, claim 1 calls for, among others, a polymer layer having a substantially uniform thickness....” The multi-stepped feature of Figure 14 clearly does not meet the substantially uniform limitation. Here, the Office has merely located a protrusion within the claimed range and disregarded the multi-stepped features including the presence of the two thinner steps.

Second, the claim calls for, among others, a polymer layer having a thickness of between about 0.020” to 0.065”. While Maurer may teach a substantially uniform polymer layer in the element identified as the base member (54), there is no motivation to double or quintuple its thickness to reach the claimed range.

Additionally, the change suggested by the Office, providing a substantially uniform thickness (that is without protrusions), would render Maurer unfit for its intended purpose. Specifically, the protrusions taught by Maurer are employed to control the spin imparted on a hockey puck (column 9, line 52 bridging to column 10, line 5). Removing the protrusions (that is, leaving a substantially uniform thickness on the polymer layer) would destroy Maurer’s intended use.

Alternatively, if the embodiment illustrated by Figure 14 were altered to a substantially uniform thickness, again the reference would be rendered unfit for its intended purpose. In this instance, the defect is revealed by the varying thickness of the neighboring ridges of the Figure 14 embodiment being intended to deflect a hockey puck in a downward direction. That is,

toward the surface of the ice (column 13, line 46-53). Were the ridges uniformly thick, as claimed, the puck's deflection angle would be merely a function of spin and angle of incidence.

Therefore, the rejection of Claims 1-6 and 9 are clearly improper, and the rejection should be withdrawn and the claims passed to allowance.

Regarding Claim 12, the Office posits that Guenther's teaching of a 500 micron backing (11) meets the claimed thickness of between 0.020 and 0.065 inches. This is incorrect. Readily available conversion tables reveal that 500 microns is less than 0.020 inches¹. Thus, Guenther does not teach a thickness within the claimed range and the rejection should be withdrawn and the claim passed to allowance.

Regarding Claims 7, 10 and 11, the Office has made no attempt to show that the combination proposed by the Office is suggested by either Maurer or Guenther. In particular, it is questionable whether an artisan dealing with hockey tape would encounter the teachings described in the diaper affixing apparatus of Guenther. Moreover, as the intended use of the Maurer tape is in close proximity to ice and likely to be employed in cold environments it is questionable that the rubberized double sided tape of Guenther would retain its function.

Additionally, the Office's assertion at paragraph 7 that the motivation to combine the references is to provide for enhanced peel adhesion is unfounded. Maurer appears to be concerned with controlling the direction of a hockey puck rather than improving peel characteristics. Indeed, Maurer appears satisfied with an adhesive "similar or identical" to that used on then current hockey tapes (column 9, lines 41-43). Thus, because there is no motivation

¹ Micron x 0.0000394 = inches
500 x 0.0000394 = 0.019685

In re Goecke
Ser No.: 10/674,108, Filed: 9/29/03
Docket No.: 29006-2
Pre-Appeal Brief Request for Review

to make the combination proposed by the Office, these rejections are improper and should be withdrawn.

CONCLUSION

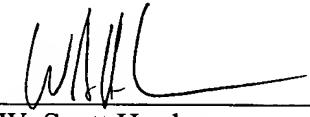
For the reasons above, Applicant believes the final rejection of the claims pending in the present application to be improper. Review, reconsideration and reversal are respectfully requested.

While no fees are believed due, the Commissioner is hereby authorized to charge any necessary fees to Deposit Account No. 02-2051, referencing Attorney Docket No. 29006-2.

Respectfully submitted,

Dated: June 22, 2006

By:


W. Scott Harders
Registration No. 42,629

BENESCH, FRIEDLANDER,
COPLAN & ARONOFF, LLP
2300 BP Tower
200 Public Square
Cleveland, OH 44114-2378
(216) 363-4443